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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,728	01/23/2004	Thomas J. Berwald	0092-18 CIP	7328

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EXAMINER	
TUGBANG, ANTHONY D	

ART UNIT	PAPER NUMBER
3729	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/763,728	BERWALD ET AL.	
	Examiner	Art Unit	
	A. Dexter Tugbang	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-59 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 11, 31 and 54, drawn to a magnetic metal component, classified in class 428, subclass 826.

II. Claims 1-10 and 12-19, drawn to a process of adhesively bonding a magnetic metal, classified in class 156, subclass 184.

III. Claims 20-30, 32-53 and 55-59, drawn to a process of making a magnetic metal, classified in class 29, subclass 603.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups II, III and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group I can be made by a materially different process, such as one that utilizes a self sticking adhesive without any need for curing or thermal processing.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Inventions of Groups II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is

separately usable. In the instant case, the subcombination of Group III has separate utility, or a separately usable process of milling, which has a materially different manufacturing effect from Group I and is also not required in Group I. See MPEP § 806.05(d).

5. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. If applicant(s) elect the invention of Group III, then a restriction to one of the following inventions is required under 35 U.S.C. 121:

III-A. Claims 22 and 24-28, drawn to a process that includes applying an adhesive with an atmospheric soak process, classified in class 156, subclass 314.

III-B. Claims 23-28, drawn to a process that includes providing a vessel containing the adhesive, classified in class 156, subclass 285.

III-C. Claim 33, drawn to a process that includes removing a toroid from a milling assembly, classified in class 29, subclass 426.2.

III-D. Claims 35-53 and 55-59, drawn to a process that includes placing an inner ring, an outer ring, and a hat, classified in class 29, subclass 609.

III-E. Claims 29, 30, 48 and 49, drawn to a process that specifically mills with a cutting tool, classified in class 409, subclass 66.

7. Inventions of Groups III-A through III-E are directed to related inventions of a magnetic metal. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different

design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, each Group, e.g. III-A through III-E, has a materially different manufacturing function and effect.

Group III-A requires applying an adhesive with an atmospheric soak process, that is not required in any of Groups III-B through III-E.

Group III-B requires providing a vessel containing the adhesive and evacuating the vessel, that is not required in Groups III-A and III-C through III-E.

Group III-C requires removing a toroid from a milling assembly, that is not required in any of Groups III-A, III-B, III-D and III-E.

Group III-D requires placing an inner ring, an outer ring and a hat, that is not required in any of Groups III-A through III-C and III-E.

Group III-E requires specific milling operations of milling with a cutting tool in relation to a winding axis, that is not required in Groups III-A through III-D.

8. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Claims 20, 21, 32 and 34 link(s) inventions of Groups III-A through III-E. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), Claims 20, 21, 32 and 34, with the invention of Group III. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 Claims that require all the limitations of an allowable linking claim will be

entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim(s) including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

10. If applicant(s) elect the invention of Group II, then this application contains claims directed to the following patentably distinct species:

Species A, Claims 2, 6-10, 13 and 15;

Species B, Claim 3;

Species C, Claim 4; and

Species D, Claims 5-10 and 13-15.

The species are independent or distinct because of how the adhesive is applied:

Species A requires an atmospheric soak process, not required in Species B through D;

Species B requires a spray process, not required in Species A, C and D;

Species C requires electrolytic deposition during winding, not required in Species A, B and D; and

Species D requires a vessel that is evacuated not required in Species A through C.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 12 and 16-19 are generic in the invention of Group II.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

11. Due to the great complexity of the above restriction requirement, the examiner did not call the applicant(s) to request an oral election.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the

inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A. Dexter Tugbang
Primary Examiner
Art Unit 3729

July 26, 2006